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In re Application of
BRAND et al.
Application No.: 09/980,972
PCT No.: PCT/DE00/01416
Int. Filing Date: 02 May 2000
Priority Date: 30 April 1999
Attorney Docket No.: 101196-66
For: AGENT FOR GENE THERAPY AND
FOR THE PREVENTION OF
METASTASES, AS WELL FOR THE
GENE THERAPY OF TUMORS

DECISION ON
PAPERS UNDER 37 CFR 1.42

This is a response to the declaration filed 14 March 2002, which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 02 May 2000, applicants filed international application PCT/DE00/01416, which claimed a priority date of 30 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 November 2000. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 30 October 2001.

On 29 October 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a preliminary amendment.

On 30 January 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that oath or declaration executed by the inventor and an English translation of the international application was required. The notification set a TWO (2) MONTH period for response.

On 14 March 2002, applicants filed a translation of the international application and a declaration/power of attorney executed by: Karsten Brand and Andrew Baker as inventors; and Irene Strauss on behalf of deceased inventor Michael Strauss.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 14 March 2002 was executed by Irene Strauss as "legal representative (or heirs)" to the deceased inventor Michael Strauss. However, the declaration is unclear as to whether Irene Strauss is the legal representatives or sole heir of the deceased inventor. Accordingly, the declaration fails to identify the proper relationship under 37 CFR 1.497(b)(2).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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